

REMARKS

I. The Office Action Should Be Vacated

Applicants respectfully request that the Office Action be vacated.

In the Office Action, “claims 1, 3-4, 6, 10-15, 17, 18, 31-35 and 37 are rejected as allegedly being anticipated by [U.S. Published Application No. 2003/0101902 (hereinafter “Reitnauer”)].” Of these claims supposedly anticipated by Reitnauer: claims 1, 6, 18, 31 and 32 were previously cancelled; while the rest of the claims, except for claim 37, are dependent claims. (Claims 3-4 depend from claim 33, claims 10-15, 17 depend from claim 7, claims 33-34 depend from claim 20, and claim 35 depends from claim 36).

In the same Office Action, claims 5, 7, 8, 16, 19, 20, 22, 23, 25, 26, 28-30, 36 and 38-41 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Reitnauer in view of U.S. Published Application No. 2002/0114878 (“Ben-Yoseph”). Note that claims 7, 16, 20, 36 and 38-41 are independent claims.

It is inconsistent to reject dependent claims as anticipated without rejecting the corresponding independent claims on the same grounds. See, e.g., Minnesota Mining and Manufacturing Company v. Chemque, Inc., 303 F.3d 1294 (Fed. Cir. 2002). The Examiner clearly did not intend to reject the independent claims as anticipated, because the Office Action states: “Reitnauer . . . fails to teach the specific printing method.” (Office Action, page 4), and anticipation by a prior art reference under Section 102, requires every element of the claim to be found in the reference. In re Bond, 910 F.2d 831, 832 (Fed. Cir. 1990).

It appears likely that the Examiner intended to drop the rejection under 35 U.S.C. § 102 in favor of the new rejection under 35 U.S.C. § 103 over Reitnauer in view of

Ben-Yoseph, and simply intended to restate the substance of what Reitnauer is alleged to teach from a previous Office Action. However, the status of the claims is completely unclear at the present time and clarification is requested. Accordingly, it is requested that the final Office Action be vacated.

II. The Ben Yoseph Published Application Is Not Prior Art

The Ben Yoseph Published Application (now U.S. Patent No. 6,893,671) and the present application are commonly owned by Mars, Incorporated. Thus, insofar as this publication is applied in a rejection under Section 103, the reference must be a valid reference under 35 U.S.C. § 102(a). Moreover, “Applicant’s disclosure of his or her own work within the year before the application filing date cannot be used against him or her under 35 U.S.C. § 102(a). In re Katz, 687 F.2d 450 (C.C.P.A. 1982).

The inventorship of the two cases is almost identical. Of the inventors named in the Ben Yoseph published application, only Suresh Narine is not also an inventor in the present application. As set forth in the accompanying Declaration of Thomas M. Collins, the subject matter disclosed in the Ben Yoseph application relied upon in the rejection under Section 103 (*i.e.*, the “specific printing method” yielding a high resolution image) was invented by the inventors herein.

Applicants submit that the Declaration establishes that the reference is not “by another” as required under Section 102(a), and the Ben Yoseph reference may not be relied upon in a rejection as it is applicants’ own work.

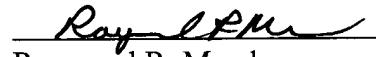
Note that the exact situation is provided for in M.P.E.P. 715.01(a). Pursuant to that section, it is not necessary to present a disclaimer by the "other" patentee, in this case Suresh Narine.

CONCLUSION

The claims being allowable for the reasons set forth on the record, applicants respectfully request favorable action on the merits and prompt issuance of a Notice of Allowance.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,


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